IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. 330

JAMES W. WABER,

Petitioner,

vs.

MONTGOMERY WARD & CO., INCORPORATED, AND UNITED STATES RUBBER COMPANY,

Respondents.

PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT WITH AFFIDAVIT AND BRIEF IN SUPPORT THEREOF.

GEORGE I. HAIGHT,
M. K. HOBBS,
CARL HOPPE,
Attorneys for Petitioner.

1041 Rookery Building,
209 South LaSalle Street,
Chicago 4, Illinois.

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PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT WITH AFFIDAVIT AND BRIEF IN SUPPORT THEREOF.

To the Honorable, the Chief Justice and the Associate Justices of the Supreme Court of the United States:

James W. Waber files this petition for the writ of certiorari because the Circuit Court of Appeals for the Seventh Circuit, in entering a decree in a patent infringement suit, enunciated a novel, but erroneous, test of invention which has never been suggested by this Court and which is contrary to all tests approved and applied throughout the years.

For this reason, and others to be developed in the petition and brief in support thereof, James W. Waber respect-

fully petitions this Court to issue the writ of certiorari to review a decree of the United States Circuit Court of Appeals for the Seventh Circuit. The decree was entered on May 19, 1945 (R. 471) and it affirmed a final judgment of a Federal District Court (R. 338) adjudging that Letters Patent No. 1,808,091 duly issued by the Patent Office of the United States, are invalid.

The Petitioner accompanies this petition with a brief in support thereof and a certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, in compliance with Rule 38, Section 1, Rules of this Court.

SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

On August 19, 1941 the petitioner filed a complaint (R. 2-5) in the United States District Court, Northern District of Illinois, Eastern Division, charging that respondents' products, "Airlock" Safety Tubes and "Master Seal" Tubes, infringed the petitioner's patent No. 1,808,091. This patent covers a puncture sealing pneumatic inner tube for use in automobile tires and its method of manufacture (R. 352-356). The application was filed on August 9, 1930 and was issued as a patent on June 2, 1931. It covers subject matter partially described in an earlier application filed on August 14, 1929 (R. 93-94) and abandoned by failure to respond to an office action of May 20, 1931 (Page 18, Exhibit N). During the prosecution of these two applications eight prior art patents were cited, including three later cited by the respondents in their answer and relied upon by the trial Court in its decision.

On November 26, 1941, the respondents filed their answer (R. 5-9), which among other things, denied infringement and asserted that said Letters Patent were invalid.

An amendment to the answer was filed on November 17, 1943 (R. 9-10). On the question of invalidity, the respondents relied upon twenty-eight patents as prior art (R. 7, 10) covering a cross section of the efforts of others from October 2, 1899 to October 27, 1931.

The trial commenced November 22, 1943 (R. 11). The testimony heard by the Court is printed at R. 20-262.

After the close of the testimony, and on December 23, 1943, the District Court handed down its oral decision (R. 325-332) that the patent in suit was infringed by the respondents but that it was invalid because it "is either anticipated by the prior art * * * or * * * it fails to disclose invention over such prior art" (R. 331). The trial Court found pertinent eight United States Letters Patent out of the twenty-eight cited by the respondents. Chronologically, beginning with the filing of the first patent and ending with the issuance of the last, the art relied upon by the Court evidences the development of the art from April 12, 1917 to September 4, 1928.

The trial Court relied upon the Wildman patent 1,601,013 (R. 328-330, 428), the Crombie patent 1,498,017 (R. 330, 412), the Armstrong patent 1,311,738 (R. 330-331, 406), the Wildman patent 1,507,646 (R. 331, 416), the Ostberg patent 1,565,813 (R. 331, 422), the Fetter patent 1,683,454 (R. 331, 432), the Ott patent 1,765,093 (R. 331, 436), and the Wallace patent 1,258,506 (R. 331, 392).*

On January 10, 1944, the District Court entered its findings of fact and conclusions of law (R. 332-338), prepared

*The Wildman ('646), Fetter and Ott patents referred to above were cited by the Patent Office in the prosecution of the applications leading up to the issuance of the patent in suit. The two Wildman patents and the Crombie patent were discussed in detail by the trial Court. It included the remainder as a group "all in point." They were not specifically discussed. The Wallace, Wildman ('013), and Crombie patents were relied upon by the Circuit Court of Appeals in its decision.

by counsel for respondents (R. 331), and entered a final judgment (R. 338) adjudging the patent invalid.

On April 5, 1944, the petitioner filed his notice of appeal to the Circuit Court of Appeals for the Seventh Circuit (R. 339) which appeal was duly perfected and, on April 18, 1945, the Circuit Court of Appeals heard the petitioner's appeal (R. 463).

On May 19, 1945 the Circuit Court of Appeals entered its decree (R. 471) affirming the judgment of the District Court. The decree is supported by a published opinion (R. 464-471) reported in ... F. (2nd) ... and in 65 U. S. P. Q. 389. Of the twenty-eight prior art patents set up in the answer and the eight prior art patents relied upon by the District Court, the Circuit Court of Appeals found only three to be pertinent, namely, in order of importance, the Wallace patent 1,258,506 (R. 467, 392), the Wildman patent 1,601,013 (R. 467, 428), and the Crombie patent 1,498,017 (R. 467, 412).

In its opinion, the Circuit Court of Appeals stated that the Waber patent was anticipated by the Wallace patent and by the Wildman patent (R. 468-470).

That anticipation is lacking will be developed in the brief in support hereof. Waber discloses a new four step process. The Court of Appeals found that two of the four steps were not disclosed (R. 467-468) in Wallace (R. 392). With respect to the Wildman patent (R. 428), the Court's opinion states that the anticipating "language is not entirely clear" but nevertheless, "assuming, as we think we must," (R. 469) that Wildman "could be constructed" on an inflated tube, reached the conclusion of anticipation (R. 470). Such a disclosure does not support the anticipation defense.

There is no finding by either court that the "improvements (of Waber) were patented and described" in Wal-

lace, Crombie or Wildman, as pleaded in paragraph 14 (a) of the answer (R. 6-7) or that the same "were known and used by" them as pleaded in paragraph 14 (b) (R. 7).

In view of the lack of anticipation, the test of invention which was applied by the Circuit Court of Appeals is most important. Here lies the crux of the error of law made by the Circuit Court of Appeals and one which wholly substantiates this petition for the writ of certiorari. The Circuit Court of Appeals applied a new and unusual test, a test never suggested by this court nor contemplated by the Congress. The Circuit Court of Appeals' opinion states that invention is lacking because

> "a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber" (R. 470).*

The editor of U. S. P. Q. in headnote 2 of the reported decision, states the new rule of the Circuit Court of Appeals as follows, 65 U. S. P. Q. 389:

> "* * * Court holds patent invalid since person skilled in art **could have duplicated** patentee's accomplishment by studying and understanding prior art."

The enunciation of this mistaken rule by the Circuit Court of Appeals is important both to the public and to this petitioner. If the rule be perpetuated, then it is obvious that few, if any, patents can be valid. This new rule is so strict that it forbids application of the "flash of genius" rule recently enunciated by this Court. Without its novel test, the Court's application of established tests would have impelled a finding that invention bred the Waber tube.

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*All emphasis used in the petition and brief in support thereof is added by the petitioner except as otherwise noted.

It is also important that the Wallace, Crombie, and Wildman patents were abandoned. They did not partake of any useful or practical operation and nothing more was heard from the patentees or any other persons for a period in excess of 15 years. They were resurrected solely for the purposes of defense in this suit. They did not make a ripple on the sea of progress. Ternes, the respondents' expert, had never seen a tube made in accordance with the teachings of Wallace (R. 86), Crombie (R. 88, 89), or Wildman (R. 89). Waber testified that no prior art tubes are on the market (R. 22) and that none was or could be commercially successful (R. 199, 242, 246).

An affidavit of the petitioner is annexed to this petition, page 10, as Exhibit A. It shows that no one other than the respondents infringes the patent in suit As a result there is little likelihood that acts of infringement will occur in any Circuit other than the Seventh. Conflicting decisions directly involving the patent in suit are therefore improbable.

JURISDICTIONAL STATEMENT.

The jurisdiction of this Court is conferred by U. S. Code, Title 28, Sections 347 and 350. The judgment or decree sought to be reviewed is dated May 19, 1945 and this petition is presented within three months thereof.

THE QUESTIONS PRESENTED.

The ultimate question presented for consideration by this Court is:

1. Was the Circuit Court of Appeals justified in holding a patent invalid upon the application of a negative test of invention that a person trained and skilled in the art, by studying and understanding the prior art, could have duplicated the accomplishments of the patentee?

Subordinate questions are:

2. Does a prior art patent (the Wallace patent 1,258,506) which fails to disclose two steps of four steps of the process of the patent in suit anticipate such a patent?

3. May anticipation be "assumed" by a patent (the Wildman patent 1,601,013) where the "language is not entirely clear"?

4. Is the Waber patent 1,808,091 valid in view of the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013?

REASONS RELIED UPON FOR THE GRANT OF THE WRIT OF CERTIORARI.

The discretionary power of this Court is invoked upon any one of the following grounds:

1. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon which the entire puncture sealing tube industry is founded, which industry (with the exception of the present respondents) is concentrated within the Seventh Circuit and which patent expires on June 2, 1948 (in less than three years) whereby a resulting conflict of decision is improbable.*

2. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent on the unfair and erroneous ground that "a person trained and skilled in the (art) * * *, by studying and understanding (the) * * * prior art, could have duplicated the accomplishment of (the patentee)."

a. This holding presents a novel question of law which has never been decided by this court and one of general

*See Exhibit A, appended to this petition, page 10.

interest to the public. In principle, it is in conflict with decisions of this court.

b. This holding is contrary to the patent statutes and, therefore, is in direct conflict with applicable decisions of this court as constituting judicial legislation.

3. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a process patent comprising four steps upon the ground that it is anticipated by a prior art patent which does not disclose two of said steps. This holding is untenable because it is in direct conflict with applicable decisions of this court.

4. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent on the ground "assuming, as we think we must" that anticipation is present, although finding that the anticipating "language is not entirely clear." This holding is untenable because it is in direct conflict with applicable decisions of this court.

5. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon a broad construction beyond the disclosures of three prior art "paper" patents which failed of any useful or practical operation and from which nothing more was heard for a period of 15 years. A determination of invalidity based on such art is untenable because it is in conflict with the decisions of other Circuits Court of Appeals on the same matter and is probably in conflict with applicable decisions of this court.

6. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent as lacking invention contrary to established tests of invention. Failure to apply said tests is in direct conflict with applicable decisions of this court and with decisions of other Circuits Court of Appeals.

PRAYER.

Your petitioner prays that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit commanding said court to certify and send to this court, on a day to be designated, a full and complete transcript of the record of all of the proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this court; that the decree of the Circuit Court of Appeals affirming the final judgment of the District Court be reversed; and that the petitioner be granted such other and further relief as may seem proper.

JAMES W. WABER,
Petitioner.

By: GEORGE I. HAIGHT,
M. K. HOBBS,
CARL HOPPE,

1041 Rookery Building,
209 South LaSalle Street,
Chicago 4, Illinois.
Attorneys for Petitioner.

Dated: Chicago, Illinois
August 10, 1945.

Exhibit A.

AFFIDAVIT IN SUPPORT OF PETITION FOR THE WRIT OF CERTIORARI.

COUNTY OF COOK }
STATE OF ILLINOIS } ss.

JAMES W. WABER, being first duly sworn, deposes and says:

Affiant is the petitioner in the above entitled matter;

Affiant knows the names and addresses of persons who manufacture puncture-sealing tubes in this country in accordance with the teachings of the Waber Patent No. 1,808,091;

Affiant is informed and believes that the Seiberling Rubber Company at one time did manufacture tubes at Akron, Ohio in accordance with said teachings, but that it stopped such manufacture shortly after December 7, 1941;

The only person or persons now manufacturing such puncture-sealing tubes is or are the petitioner himself and the respondent United States Rubber Company;

The entire puncture sealing tube industry is now concentrated in the State of Illinois within the Seventh judicial circuit of the United States with the exception of the possible manufacture by the respondent United States Rubber Company.

JAMES W. WABER.

Subscribed and sworn to before me this 10th day of August, 1945.

FRANCES SAVAGE
Notary Public
Cook County, Illinois

My commission expires June 27, 1948.